

Please cancel claims 17-19 without prejudice.

### REMARKS

The specification and claim 1 have been amended, claims 23-40 have been added, and claims 17-19 have been cancelled without prejudice. No new matter has been added by virtue of the amendments. For instance, support for the new claims appears at page 5 and the original claims of the application.

The specification was objected to for a grammatical matter at page 5. The Examiner's suggestion has been adopted to obviate the objection.

At page 2 of the Office Action, it was noted that the application claims do not commence on a separate sheet. In response, substitute application pages are enclosed herewith, which includes the claims commencing on a separate sheet.

Claims 1-22 were rejected under 35 U.S.C. 112, second paragraph. Claim 1 was indicated to be indefinite on the basis that it is not clear whether the claim is a composition or process claim.

Claim 1 has been amended to delete the language noted in the Office Action, i.e. "the process for producing allyl acetate", and method claims 24-38 have been added.

It is thus believed the rejection has been obviated.

Claims 1-19 were rejected under 35 U.S.C. 102 over Bartsch (U.S. Patent 4,158,737).

Claims 20-21 were rejected under 35 U.S.C. 103 over Bartsch (U.S. Patent 4,158,737) and further in view of Sennewald (U.S. Patent 3,655,747).

Claim 22 was rejected under 35 U.S.C. 103 over Bartsch (U.S. Patent 4,158,737) and Sennewald (U.S. Patent 3,655,747) and further in view of Kronig et al. (U.S. Patent 3,822,308).

For the sake of brevity, the three Section 102 and 103 rejections are addressed in combination. Such a combined response is considered appropriate because *inter alia* each of the rejections relies on the Bartsch patent as the sole or primary citation. Each of the rejections is traversed.

Each of Applicants' claims calls for a catalyst that contains in combination palladium metal and tin. In preferred aspects, an additional metal is also present. See claims 23-24 and 27-30.

The experimental data disclosed in the application as filed shows clearly superior for catalysts of the invention that contain tin, or tin in combination with a further metal such as gold or copper. See pages 11-12 of the application, including the Table on page 11.

The Bartsch patent, whether considered alone or in combination with the other cited documents, fails to teach or otherwise suggest Applicants' claimed invention, or the significant performance advantages provided thereby.

Among other things, Bartsch does not disclose use of tin as a catalyst component as Applicants disclose and claim. Bartsch also does not disclose use of tin in combination with a further metal as Applicants claim, or the performance benefits provided by such a catalyst.

In the Office Action, column 5, lines 47-55 of Bartsch is cited for a report of tin.

S. Chen et al.  
U.S.S.N. 09/454,316  
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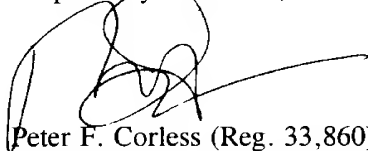
However, that citation clearly can not sustain the instant rejection. Indeed, that citation merely reports a laundry list of possible **optional** additives. None of the examples of the Bartsch patent report use of tin of any type.

Moreover, nowhere does Bartsch indicate that any of the optional materials should be used in combination with another material. Compare Applicants' claims 23-24 and 27-30, where a further metal is used together with tin. See also the comparative examples of the present application, which show excellent results for such catalysts that contain a further metal in addition to tin.

In view thereof, reconsideration and withdrawal of the rejections are requested.

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter F. Corless', is written over the typed name and firm name.

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**MARKED VERSION TO SHOW CHANGES**

**IN THE SPECIFICATION**

--The operation temperature of the above oxyacylation process is in the range of 100°C to 250°C, preferably 140°C to 200°C; the operation pressure is in the range of 0 to 15 kg/cm<sup>2</sup>•g, [preferable] preferably 5 to 10 kg/ cm<sup>2</sup>•g.--

**IN THE CLAIMS**

2. (amended) A catalyst for oxyacylation to produce allyl acetate, which comprises palladium metal as the main catalyst, tin metal or a mixture of tin and additional metal(s) as the promoter, in combination with an alkali or alkaline earth metal compound, supported on the outer surface of a porous carrier[, and being used in the process for producing allyl acetate].